APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,703	01/18/2001	Takako Asahi	862.C2089	4719

5514 7590 09/20/2005	EXAMINER
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ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/761,703	ASAHI, TAKAKO
	Examiner	Art Unit	
	Lucas Divine	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 August 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-7,10,13 and 14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-7,10,13 and 14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03 December 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 8/4/05 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 10, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kida et

al. (US 5852764).

Regarding claim 10, Kida teaches **an image forming apparatus (Fig. 2) which can be**

connected to a sheet processing apparatus (5) having a plurality of sheet storage units (Fig.

1 trays 53, 59, see also col. 30 line 36), **and has a plurality of operation modes including at**

least two modes from among a copy mode, an image communication mode, and a printer

mode (col. 18 lines 54-56), wherein any one of the plurality of operation modes can be

assigned to each of the plurality of sheet storage units (Fig. 8, col. 19 lines 25-35 teach that

the sheet is stored in the output tray according to the output mode selected for it, see also col. 2

lines 30-33 and col. 18 lines 65-67), **said apparatus comprising:**

display control means (operation panel unit 45, Fig. 4) **for displaying display windows**

corresponding to the operation modes on a display device independently for the respective

operation modes (the display window 6 inherently displays information corresponding to the

selected operation mode in order to provide the user unique options and settings for each; for

example, the fax mode has dialing options that would only be displayed for the fax mode); **and**

control means (sheet control unit 46, Fig. 4, col. 12 lines 29-34, col. 16 lines 27-29) **for,**

in response to said display control means switching to display a window corresponding to

an operation mode amount the plurality of operation modes, controlling the sheet

processing apparatus so as to enable a sheet storage unit, which is assigned to the switched

operation mode, to store a sheet (col. 2 lines 5-10, teaching shifting transport paths in the sorter

based on what mode is selected – col. 4 line 66 – col. 5 line 3 further teach the sheet 'can' [is

enabled to] be discharged onto the appropriate tray as selected according to the mode) **even if**

not receiving a job data for the switched operation mode (as shown in Fig. 4, the sheet

control unit 46 never receives job/image data, just information about what mode the printer is

currently in – the job data [Fig. 4] comes in on CCD 2-4, is processed and stored by 41, 43, and

is output or communicated in 42 or 47).

Regarding claim 13, the structural elements of apparatus claim 10 perform all of the steps

of method claim 13. Claim 13 is therefore rejected for the reasons stated in the rejected claim

10.

Regarding claim 14, the operation of the program storage medium of claim 14 performs

the steps of method claim 13 within a computer readable medium. Therefore, claim 14 is rejected

for the reasons stated in the rejection of method claim 13. Kida further teaches the use of a CPU

44 capable of performing the method steps as claimed in claim 13 as well as hard disk 43 to store

the necessary program data and steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1, and 3 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kida

in view of Kawamura et al. (US 5587799).

Regarding claim 1, Kida teaches **an image forming apparatus (Fig. 2) which can be**

connected to a sheet processing apparatus (5) having a plurality of sheet storage units (Fig.

1 trays 53, 59, see also col. 30 line 36), **and has a plurality of operation modes including at**

least two modes from among a copy mode, an image communication mode, and a printer

mode (col. 18 lines 54-56, Fig. 8), **said apparatus comprising:**

control means (Fig. 4, sorter control unit 46 controls the sheet output) **for, in response**

to <u>setting the image forming apparatus</u> to a predetermined operation mode, controlling the

sheet processing apparatus so as to <u>enable a storage sheet unit, which is assigned to a</u>

<u>predetermined mode, to</u> store a sheet in a sheet (Fig. 8, col. 19 lines 25-35 teach that the sheet

is stored in the output tray according to the operation mode - col. 2 lines 5-10, teaching shifting

transport paths in the sorter based on what mode is selected – col. 4 line 66 – col. 5 line 3 further

teach the sheet 'can' [is enabled to] be discharged onto the appropriate tray as selected according

to the mode) **even if not receiving a job data for the switched operation mode** (as shown in

Fig. 4, the sheet control unit 46 never receives job/image data, just information about what mode

the printer is currently in – the job data [Fig. 4] comes in on CCD 2-4, is processed and stored by

41, 43, and is output or communicated in 42 or 47).

While Kida teaches an image forming apparatus with operation modes and an initial state

(col. 38 line 53) and normal mode (col. 13 lines 12-13) as well as discusses the desire to put the

mode that is 'mainly used' in the top try for best accessibility (col. 3 lines 35-50 and col. 5 lines

10-15), Kida does not specifically teach a **determining of a no-operation state for a**

predetermined time or shifting the operation mode based on the determining result.

Kawamura teaches an image forming apparatus with operation modes **determination**

means for determining whether a no-operation state by an operator continues for a

predetermined time (col. 6 lines 4-5 and 12-13 teaches the determining the if a predetermined

time has elapsed since the last user 'key' operation); **and**

auto-clear operation means for automatically setting the image forming apparatus

to a predetermined operation mode from among of the plurality of operation modes on the

basis of a determination result of said determination means (Kawamura teaches reverting

'nullified' to a default device mode when the device is not operated for a predetermined time;

col. 6 lines 1-14).

Kida and Kawamura are combinable because they both teach image forming apparatuses with operation modes, user operation areas, sheet storage units, and photocopy units.

It would have been obvious to one of ordinary skill in the art to shift modes based on the no-operation time determining unit of Kawamura in the mode-shifting device of Kida. The motivation for doing so would have been to automatically place the device in a 'default' or 'normal' mode if there has not been activity for a while, saving the next user time and effort if they (predictably) would want to use the 'normal' mode. This would be advantageous in the system of Kida because Kida teaches that the 'normal' mode of the taught invention is for copying (col. 1 line 14, wherein the normal mode is copying; col. 3 lines 35-50 and col. 5 lines 10-15). One can conclude that this 'normal' mode is the mode most used and therefore for it is most likely that a user will use this mode. Further, remote devices generally input fax and print jobs, so at the local machine, the copy function can be assumed as the most used by an operator of the operation means. Adding the determining unit of Kawamura would place the invention of Kida in the 'normal' mode after a certain no-operation time, and thus save the next user time and effort if they (predictably) would want to use the chosen 'normal' mode.

Regarding claim 3, which depends from claim 1, Kida teaches **a user interface including a display device commonly used in the respective modes** (touch panel liquid crystal display 6 shown in Figs. 5 and 8 inherently must show windows corresponding to the modes in order for the user to select mode options for each),

wherein in response to said auto-clear operation means setting the image forming apparatus to the predetermined operation mode, display control is performed to display a display window corresponding to the predetermined operation mode (since the shifting

means shifts the *mode* in claim 1, it is inherent that the display would shift as well because the device itself is shifting modes, not just the sheet apparatus).

Regarding claim 4, which depends from claim 1, the combination further teaches **setting means for selecting a mode to be set to by said auto-clear operation** (in order to have a predetermined mode to automatically set to in claim 1, the mode to be shifted to must have been selected).

Regarding claim 5, which depends from claim 1, Kida further teaches a system **further comprising setting means for performing setting of assigning any one of the plurality of operation modes to each of the plurality of sheet storage units** (Fig. 8).

Regarding claim 6, the structural elements of apparatus claim 1 perform all of the steps of method claim 6. Claim 6 is therefore rejected for the reasons stated in the rejected claim 1.

Regarding claim 7, the operation of the program storage medium of claim 7 performs the steps of method claim 6 within a computer readable medium. Therefore, claim 7 is rejected for the reasons stated in the rejection of method claim 6. Kida further teaches the use of a CPU 44 capable of performing the method steps as claimed in claim 6 as well as hard disk 43 to store the necessary program data and steps.

Response to Arguments

4.   Applicant's arguments with respect to amendment filed 8/4/2005 have been fully considered but they are not persuasive.

With regards to applicant's argument on page 15 that *Kawamura et al. has substantially different modes from the present invention and Kawamura does not teach control means.*

In reply, since Kida teaches switching between modes such as a copy, image communication, and fax modes (Fig. 8), Kawamura is relied upon to as teaching the automatically switching between modes of a printer (col. 6 lines 1-14). Thus, the combination itself teaches automatically switching between modes such as copy, image communication and fax. Further in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Kawamura reference is responding not to what type of modes, but more to the question: would it have been obvious to one of ordinary skill in the art to switch modes in a copier after a predetermined time (as recited in the claim)? Examiner believes for the motivations listed above and for possibly others, it would have been obvious, and Kawamura teaches that it was known in the art to do so.

Further, Examiner has cited Patents below that all teach similar auto-clear features to Kawamura, further showing how well known and obvious the idea of switching copier modes after predetermined times would have been.

US-5546166, Hirota et al., 8-13-1996: teaches image forming apparatus with *auto-clear* function, see specifically detailed description (emphasis added).

US-4502776, Matsumoto et al., 3-5-1985: teaches sorting device for use with document reproduction machine, see specifically col. 2 lines 25-29.

US-6278526, Kurozasa, 8-21-2001: teaches image processing system for enabling setting of operation mode from external computer, see specifically col. 6 lines 51-55.

With regards to applicant's arguments regarding claims 10, 13, and 14 that *Kida fails to teach or even suggest controlling a sheet storage unit which is assigned to the switched operation mode when a display window corresponding to any one of the plurality of modes is displayed on the display device, so as to store a sheet even if not receiving job data for displayed operation mode.*

In reply, the amended claim 10 reads that the control means performs enables the sheet storage unit to store a sheet even if it is not receiving a job data for the switched mode (paraphrased). Kida teaches when modes are switched, the sheet controlling apparatus 5 is enabled by control means 46 to store a sheet in the correct tray for that mode. Kida does NOT teach that job data goes to or would ever go to the sheet control unit 46 (control means), so therefore, Kida clearly teaches that the sheet control unit 46 enables sheet storage even if it is not receiving job data, because it always enables sheet storage, but never receives job data, thus clearly reading on the newly amended claim limitation.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lucas Divine
Examiner
Art Unit 2624

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ljd

KING Y. POON
PRIMARY EXAMINER